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**OFFICE OF PETITIONS**

In re Patent No. 6,951,841	:	LETTER REGARDING
Neuer et al.	:	PATENT TERM ADJUSTMENT
Issue Date: October 4, 2005	:	and
Application No. 09/738,212	:	NOTICE OF INTENT TO ISSUE
Filed: December 15, 2000	:	CERTIFICATE OF CORRECTION
Attorney Docket No. 4-118-8353B/C1	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF FINAL PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 CFR §1.705(d)," filed December 2, 2005. Patentees disclose that the patent term adjustment indicated in the patent should be corrected from five hundred twenty-seven (527) days to seventy-six (76) days.

The request for correction of the patent term adjustment indicated in the patent is GRANTED to the extent indicated herein.

Patentees are given **TWO (2) MONTHS** from the mailing date of this decision to respond. No extensions of time will be granted under § 1.136.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one hundred forty-one (141) days.

On October 4, 2005, the above-identified application matured into U.S. Patent No. 6,951,841. The Patent issued with a Patent Term Adjustment of 527 days. Pursuant to their duty of good faith and candor to the Office, patentees disclose that this patent term adjustment is incorrect because 1) the BPAI (Board of Patent Appeals and Interferences) decision was treated as a favorable decision when in fact the BPAI decision was unfavorable, and 2) the calculation of the period of adjustment for the Office taking in excess of three years to issue the patent incorrectly included time consumed by review by the BPAI.

Patentees further disclose that the patent is subject to a terminal disclaimer.

The patent term calculations have been reviewed and it is concluded that:

The entry of a period of adjustment of 139 days for examination delay is incorrect. Patentees are correct that the BPAI decision issued by the Board was not a decision reversing an adverse determination of patentability. However, this was not the basis for the entry of this adjustment. A review of the record confirms that the BPAI decision was correctly entered as one affirming the examiner (and thus, an unfavorable decision). Nonetheless, the entry is incorrect. There was, otherwise, no examination delay during appellate review (i.e., no examination delay in mailing the examiner's answer). The rules do not provide for entry of a period of adjustment for the Office taking more than 4 months to mail a BPAI decision after the filing of a reply brief. Accordingly, the entry of the period of adjustment of 139 days is not warranted and is being removed.

Furthermore, the entry of a period of adjustment of 393 days for Office delay in acting on the BPAI decision is incorrect. Rather, a period of adjustment should have been entered for Office delay in responding to applicants' response to the Board Decision. On the record, applicants previously established that a terminal disclaimer was filed on January 8, 2004. However, the Office took until April 7, 2005 to mail a Notice of Allowance in response. Pursuant to 1.702(a)(2), a period of adjustment of 334 days should have been entered for Office delay from May 8, 2004 to April 7, 2005.

It is further noted that the application became abandoned for failure to respond to the Board Decision. By Notice of Abandonment mailed March 15, 2004, the application was abandoned. On July 15, 2004, a petition to withdraw the holding of abandonment was filed. By decision mailed October 4, 2004, the petition was granted on the grounds that applicants had shown that the response was timely filed. A period of reduction of 61 days is properly taken for applicant taking in excess of two months to file the petition to withdraw holding of abandonment.

Moreover, the entry of a period of adjustment of 127 days for the Office taking in excess of three years to issue the patent is incorrect. Patentees are correct that any time consumed by appellate review is not included in this period. However, patentees are incorrect in their calculation that excluding the

period consumed by appellate review a period of 208 days should still be entered for Office delay in issuing the patent.

First, of all, 37 CFR 1.703(b) pertains to the provisions of 35 U.S.C. 154(b)(1)(B) and indicates that the period of adjustment under 37 CFR 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the actual filing date of the application and ending on the date a patent was issued. 37 CFR 1.703(b) also sets forth the limitations on patent term adjustment specified in 35 U.S.C. 154(b)(1)(B)(i) and (ii). Specifically, 37 CFR 1.703(b) provides, in pertinent part, that the period of adjustment of the term of a patent shall not include the period equal to the sum of the following periods:

- ... (4) the period of pendency consumed by appellate review under 35 U.S.C. 134, 141, 145, whether successful or unsuccessful (35 U.S.C. 154(b)(1)(B)(ii)).

In this instance, the period of pendency consumed by appellate review counting the number of days in the period from the filing of a notice of appeal on August 16, 2002 until the mailing of the BPAI decision on November 10, 2003 is four hundred fifty-one (451) days.

The patent issued on October 4, 2005, three years and 659 days, after its filing date of December 15, 2000. The period of delay under 35 U.S.C. 154(b)(1)(B) and § 1.702(b) is 659 days. See § 1.703(b). However, if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004). In this instance, the periods of delay totaling 532 days attributable to grounds specified in § 1.702(a)(2) (139 days) and § 1.702(a)(3) (393 days) overlap with the 659 days attributable to the delay in the issuance of the patent. Thus, the period of adjustment cannot exceed the actual number of days of delay of 659 days.

Accordingly, at issuance of the patent, a period of adjustment of 127 days was entered so that the patent term adjustment would include a total number of days of delay of 659 days. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

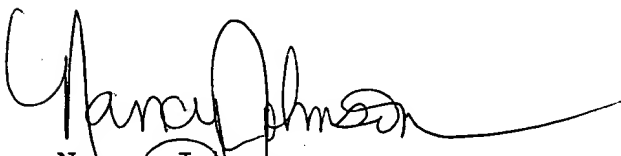
However, as stated by patentees, the period of delay under 35 U.S.C. 154(b)(1)(B) and § 1.702(b) should not include the time, 451 days, consumed by the unsuccessful appellate review. Thus, the period of delay under 35 U.S.C. 154(b)(1)(B) and § 1.702(b) is 208 days. The corrected periods of adjustment, discussed above, totaling 334 days attributable to grounds specified in 1.702(a)(2) days overlaps with the 208 days attributable to the delay in issuance of the patent. As such, the days of delay for Office issuance of the patent more than 3 years after the filing date will not result in any additional patent term.

In view thereof, the patent should have issued with a revised patent term adjustment of one hundred forty-one (141) days.

As this letter was submitted as an attempted advisement to the Office of an error in Patentees' favor, the Office will not assess the \$200.00 application fee under 37 CFR 1.705(b). The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by ONE HUNDRED FORTY-ONE (141) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

  
Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction